UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,631	04/17/2001	David A. Hughes	50P4092	7211

24337	7590	02/28/2006

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EXAMINER
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ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
09/836,631</td><td>Applicant(s)
HUGHES ET AL.</td></tr>
<tr><td>Examiner
Cristina Owen Sherr</td><td>Art Unit
3621</td></tr>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 October 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-28</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-28</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This communication is in response to applicant's amendment filed October 25,

2005. Claims 1-28 are pending in this case.

Response to Arguments

2.   Applicant's arguments with respect to claims 1-28 have been considered but are

moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

5.   Independent claims 1, 14 and 22 refer to the following:

" . . . consumer may connect"

"... consumer wishes the transaction"

". . .data may be executed"

". . . data may be processed"

". . . data may be subject".

6.   The terms "may" and "wishes" are indefinite terms that fail to properly set forth

the metes and bounds of the invention. These are not positive limitations, but rather

expressions of something might or might no occur. For these reasons, independent

claims 1, 14 and 22 and their dependent claims 2-13, 15-21 and 23-28 are rejected

under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Fritsch (US 6,233,682) in view of Silverbrook (US 6,459,495), further in view of

Dwek(US 6,248,946) .

4.   Regarding claim 1 –

Fritsch discloses a method of facilitating a transaction for downloadable digital data over

an electronic network, the method comprising: maintaining a presence on the electronic

network to which a consumer may connect; transmitting a page from the presence to

the consumer over the electronic network, the page including information concerning

the downloadable digital data; receiving a command from the consumer over the

electronic network indicating that the consumer wishes the transaction for the

downloadable digital data (e.g. Figure 1 A-E).

5.   Fritsch does not disclose, but Silverbrook does, having the consumer or user

choose among format options according to at least one of (i) types of software on which

the downloadable digital data may be executed; (ii) types of portable devices on which

the downloadable digital data may be stored; (iii) types of compression formats in which

the downloadable digital data may be configured; (iv) types of CODECs through which

the downloadable digital data may be processed; and (v) types of digital rights

management algorithms to which the downloadable digital data may be subject (e.g. col

346 ln 47-51). Also in Dwek "(a) user may edit an existing user-defined channel by

selecting the edit button 392. When the user highlights a user-defined channel and

selects the edit button 392, a dialog box is opened on the computer display screen

showing the user-defined channel name and the musical preferences for the user-

defined channel. The user may edit those preferences to change the musical format of

the user-defined channel" (col 10 ln 60-66).

6.   It would be obvious to one of ordinary skill in the art to combine the teachings of

Fritsch, Dwek and Silverbrook in order to obtain greater ease and security in data

transaction.

7.   Regarding claims 2-6-

Silverbrook discloses at least one of (i) a given type of software is compatible with

respective subsets of at least one of the types of compression formats, the types of

digital rights management algorithms, and the types of portable devices; (ii) a given type

of compression format is compatible with respective subsets of at least one of the types

of software, the types of digital rights management algorithms, and the types of portable

devices; (iii) a given type of digital rights management algorithm is compatible with

respective subsets of at least one of the types of software, the types of compression

formats, and the types of portable devices; and (iv) a given type of portable device is

compatible with respective subsets of at least one of the types of software, the types of

compression formats, and the types of digital rights management algorithms; further

comprising permitting selection by the consumer from among only the compatible

respective subsets of at least one of the types of compression formats, the types of

digital rights management algorithms, and the types of portable devices, when the given

type of software is selected by the consumer; further comprising permitting selection by

the consumer from among only the compatible respective subsets of at least one of the

types of software, the types of digital rights management algorithms, and the types of

portable devices, when the given type of compression format is selected by the

consumer; further comprising permitting selection by the consumer from among only the

compatible respective subsets of at least one of the types of software, the types of

compression formats, and the types of portable devices, when the given type of digital

rights management algorithm is selected by the consumer; further comprising permitting

selection by the consumer from among only the compatible respective subsets of at

least one of the types of software, the types of compression formats, and the types of

digital rights management algorithms, when the given type of portable device is selected

by the consumer; wherein the downloadable digital data includes at least one of audio

data, video data, and text data; wherein each type of software, each type of

compression format, each type of digital rights management algorithm, and each type of

portable device is displayed on the page and selectable by way of activation by the

consumer (e.g. col 346 ln 47-51).

8.   "Next, the value of the output format selection switch 17 is determined by the

Artcam processor. Dividing the print length by the corresponding length of the selected

output format the Artcam processor determines the number of possible prints and updates the liquid crystal display 15 with the number of prints left. Upon a user changing the output format selection switch 17 the Artcam processor 31 re-calculates the number of output pictures in accordance with that format and again updates the LCD display 15." (col 346 ln 47-51)., Further in Dwek, "(a) user may edit an existing user-defined channel by selecting the edit button 392. When the user highlights a user-defined channel and selects the edit button 392, a dialog box is opened on the computer display screen showing the user-defined channel name and the musical preferences for the user-defined channel. The user may edit those preferences to change the musical format of the user-defined channel" (col 10 ln 60-66).

9.   As above, it would be obvious to one of ordinary skill in the art to combine the teachings of Fritsch, Dwek and Silverbrook in order to obtain greater ease and security in data transaction.

10.   Regarding claim 9 –

Fritsch discloses the method of claim 8, further comprising receiving the consumer's selection of at least one of the type of software, the type of compression format, the type of digital rights management algorithm, and the type of portable device, over the electronic network at the presence (e.g. col 1 ln 30-65).

11.   Regarding claim 10 –

Fritsch discloses the method of claim 9, further comprising transmitting the downloadable digital data to the consumer over the electronic network in a format consistent with at least one of the selected type of software, the selected type of

compression format, the selected type of digital rights management algorithm, and the

selected type of portable device (e.g. Figure 1D).

12.   Regarding claim 11 –

Fritsch discloses the method of claim 10, further comprising storing at least one of the

selected type of software, the selected type of compression format, the selected type of

digital rights management algorithm, and the selected type of portable device (e.g.

Figure 1D).

13.   Regarding claim 12 –

Fritsch discloses the method of claim 11, further comprising designating the stored type

of software, type of compression format, type of digital rights management algorithm,

and type of portable device as default format options and transmitting the default format

options from the presence to the consumer over the electronic network via the page in

response to another command from the consumer over the electronic network indicating

that the consumer wishes another transaction for downloadable digital data (e.g. col 1 ln

30-65).

14.   Regarding claim 13 –

Fritsch discloses the method of claim 1, wherein the portable devices on which the

downloadable digital data may be stored are compliant with secure digital music

initiative (SDMI) specifications (e.g. col 1 ln 30-65).

15.   Regarding claim 14 –

Fritsch discloses the method of claim 1, wherein the electronic network is the Internet

and the presence is a web site thereon (e.g. col 3 ln 5-40).

16.   Claims 15-28 are rejected under the same terms as above.

17.   Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

18.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19.   www.digitalriver.com discloses a method for facilitating a transaction for purchasable content over an electronic network.
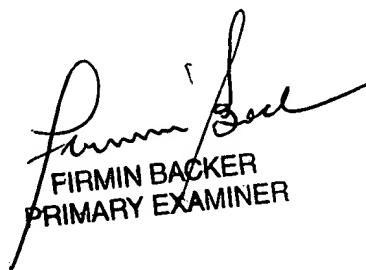
20.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

21.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

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